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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,239	01/04/2002	Edward Balassanian	3802-4058US1	8182
7590 12/14/2005			EXAMINER	
Morgan & Finnegan, L.L.P. 3 World Financial Center New York, NY 10281			NAHAR, QAMRUN	
			ART UNIT	PAPER NUMBER
			2191	
DATE MAILED: 12/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,239	Applicant(s) BALASSANIAN, EDWARD	
	Examiner Qamrun Nahar	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/16/03, 1/27/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 09/15/2005.
2. The objection to the drawings is withdrawn in view of applicant's submission of replacement sheets on 9/15/05.
3. The objection to the specification is withdrawn in view of applicant's amendment filed on 6/16/05.
4. Claims 1-17 are pending and stand finally rejected.

Response to Arguments

5. Applicant's arguments filed on 06/16/2005 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

- a) Applicant respectfully submits that the cited references do not disclose or suggest at least the first claimed feature, as noted above. ... Srivastava and Ono, individually or in combination, do not deal with the receipt of both code and specified characteristics from a developer; the evaluation of such code (in an intermediate code form) to determine whether it satisfies the developer's specified characteristic, and the notification to the developer of whether the developer's code satisfies the developer's specified characteristics.

The remaining reference Megiddo relied upon by the Examiner does not remedy the deficiencies of the Srivastava and Ono teachings. Megiddo describes an approach whereby a request for submission of modules meeting particular requirements are posted, modules are

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submitted by developers, these modules are tested from compliance with the requirements of the requestor (not the developer who is submitting a module) and a module is selected.

Accordingly, the cited references individually or in combination simply do not disclose or suggest the receipt of both code and specified characteristics from a developer and the subsequent evaluation and notification with respect to the code and characteristics from the developer.

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that the combination of Srivastava, Ono, and Megiddo fails to disclose the claimed limitations recited in claim 1. The combination of Srivastava, Ono, and Megiddo clearly shows each and every limitation in claim 1.

As previously pointed out in the last Office Action, (Mailed on 12/16/2004, par. 7), and currently maintained by the Examiner, Srivastava teaches receiving base code from a developer (Abstract "program written ... source code" – The source code interpreted as base code received from a developer.); furthermore, Ono teaches the developer code received is supplemented with developer-specified characteristics (col. 2 lines 37-52 "software part suited to the specification is retrieved"; col. 4 lines 21-28 "software part... Include... a program pattern representing a basic means for realizing a predetermined function...", - Interpreted as developer-specified characteristics used for determining col. 4 lines 58-60 "a program to be formed to satisfy the specification"). Granted the applicant is emphasizing "the receipt of both code and specified

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characteristics from a developer". Two references are relied upon for "the receipt of both code and specified characteristics from a developer", which is permissible under 35 U.S.C. 103.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). That is, Megiddo is relied upon for the limitation, "the evaluation of such code (in an intermediate code form) to determine whether it satisfies the developer's specified characteristic, and the notification to the developer of whether the developer's code satisfies the developer's specified characteristics"; not Srivastava or Ono. Furthermore, applicant has failed to specifically point out the error in the Examiner's citation provided of Megiddo for these limitations.

In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004, paragraph 7 for rejection to claim 1.

In the remarks, the applicant argues that:

b) Furthermore, absent impermissible hindsight, one of ordinary skill in the art would not combine the cited references in the piecemeal manner suggested by the Examiner. The cited references have nothing whatsoever to do with the evaluation of a developer's code according to the developer's specified characteristics and subsequent notification to the developer of the evaluation.

Examiner's response:

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b) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the remarks, the applicant argues that:

c) In addition, the cited references do not disclose or suggest sending the target code to the requester. Ono as relied upon by the Examiner simply describes an automatic program synthesizer, and appears to be silent as to how a synthesized program is provided or made available to others, such as a requester. See col. 1, lines 9-13. The Examiner asserts that it is inherent that the target code is sent to the requester. Applicant disagrees. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP 921.12 (citations omitted) (EXAMINER MUST SHOW RATIONAL OR EVIDENCE TENDING TO SHOW INHERENCY). To establish a rejection based on inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Id.* A synthesized program of Ono may be made accessible in ways other than sending to a requester. The Office

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Action does not adequately set forth any fact or technical reasoning of how the claimed sending necessarily flow from the automatic program synthesizer.

In view of the foregoing, claim 1 and its dependent claims are patentably distinguishable over the cited references, individually or in combination. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

Examiner's response:

c) Examiner strongly disagrees with applicant's assertion that the combination of Srivastava, Ono, and Megiddo fails to disclose the claimed limitations recited in claim 1. The combination of Srivastava, Ono, and Megiddo clearly shows each and every limitation in claim 1.

As previously pointed out in the last Office Action, (Mailed on 12/16/2004, par. 7), and currently maintained by the Examiner, Ono teaches receiving a request for target code from a requester (col. 4 lines 29-39 "a function requested by a target system") ... sending the target code to the requester (col. 1 lines 9-13 "synthesizing a program suitable for a target system" - It is inherent the target code is sent to requestor. If a request has been received for target code from a requester, then the target code will be sent to the requester after the target code has been created.).

In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004, paragraph 7 for rejection to claim 1.

In the remarks, the applicant argues that:

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d) Claim 13 is directed ...

For similar reasons as discussed above for claim 1, the cited references, individually or in combination do not disclose or suggest the claimed receiving, evaluating and notifying of claim 13. Accordingly, claim 13 and its dependent claims are patentably distinguishable over the cited references, individually or in combination. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

Examiner's response:

d) The Examiner has already addressed the applicant's arguments in the Examiner's Responses (a) thru (c) above. In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004, paragraph 18 for rejection to claim 13.

In the remarks, the applicant argues that:

e) Claim 15 is directed ...

As acknowledged by the Examiner, Srivastava does not disclose or suggest the claimed receiving, selecting, transforming or sending. Ono does not remedy these deficiencies in the Srivastava teaching. As discussed above, Ono describes ... As such, Ono does not disclose or suggest intermediate code from a collection of intermediate code is selected based on a requester's specified characteristics of the request, this selected code is transformed to target code according to the specified characteristics and the target code is sent to the requester.

In addition, as described above, Ono as relied upon by the Examiner simply describes an automatic program synthesizer, and appears to be silent as to how a synthesized program is

provided or made available to others. See col. 1, lines 9-13. The Examiner asserts that it is inherent that the target code is sent to the requester. Applicant disagrees. ...

Accordingly, claim 15 and its dependent claims are patentably distinguishable over the cited references, individually or in combination. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

Examiner's response:

e) The Examiner has already addressed the applicant's arguments in the Examiner's Responses (a) thru (c) above. In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004, paragraph 20 for rejection to claim 15.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

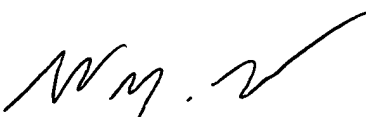
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



QN
November 30, 2005


WEI Y. ZHEN
PRIMARY EXAMINER